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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,948	06/29/2001	Shervin Erfani	3-26-22	8097
22046 7590 11/24/2008 Docket Administrator - Room 2F-192 Alcatel-Lucent USA Inc. 600-700 Mountain Avenue Murray Hill, NJ 07974				
EXAMINER				
CURS, NATHAN M				
ART UNIT		PAPER NUMBER		
2613				
MAIL DATE		DELIVERY MODE		
11/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* : SHERVIN ERFANI, VICTOR B. LAWRENCE  
and KAZEM A. SOHRABY

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Application No. 09/895,948  
Technology Center 2600

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November 24, 2008

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Before Deborah L. Perry, *Supervisory Paralegal Specialist, Review Team*  
Perry, *Supervisory Paralegal Specialist, Review Team*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on October 29, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed a communication entitled “Response to Notification of Non-Compliant Appeal Brief” dated February 1, 2008 (herein after “Response”). The purpose of the “Response” was to comply with the requirements of 37 CFR § 41.37(c) (1)(v), Appeal Brief, Summary of Claimed Subject Matter.

According to 37 CFR § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

A review of the “Response,” filed February 1, 2008, reveals that the Appeal Brief, “Summary of Claimed Subject Matter”

appearing on pages 1-3, remain deficient, because Appellant filed a corrected Summary of Claimed Subject Matter in the form of a proposed Amendment with “underlining” and strike “through’s.” this is not proper formatting.

Further, Appellant did not map the independent claims to the specification by page and line number, rather Appellant identified paragraph numbers. Although the Board of Patent Appeals has accepted mapping the independent claims to the specification by paragraph number in some instances, a review of the specification reveals that Appellants did not number the paragraphs in the specification. Therefore, Appellant must map the independent claims on appeal by page and line number. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

1) hold the Communication entitled, "Response to Notification of Non-Compliant Appeal Brief" dated February 1, 2008, defective, as required by 37 CFR § 41.37(d);

2) notify the Appellant to submit a "paper" which corrects the Appeal Brief's Summary of Claimed Subject Matter under 37 CFR §41.37(c)(1)(v). Any corrected "Summary" should not be filed in the form of an Amendment;

3) acknowledge and consider any "paper" submitted by Appellant to correct the Appeal Brief; and

4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DLP

Alcatel-Lucent USA, Inc.  
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Murray Hill, NJ 07974